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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Patent Application
For PATENT NO. 5,711,100

WILLIAM A. ELMER

Serial No. 74,598

Filing Date: June 14, 1993

For: VEHICLE ADVERTISING
SIGN, SYSTEM AND
METHOD

Primary Examiner: Brian K. Green

PROTEST OF REISSUE
APPLICATION*Reissue file: 10/098648*1. Protest Under 37 C.F.R. 1.291 and MPEP 1441.01; Supporting Declarations

This Protest of the Reissue application for Patent No. 5,711,100 (the "100 Patent") is filed pursuant to 37 C.F.R. § 1.291 and MPEP 1441.01. Identification of the Reissue application is as noted in the caption. Service of this Protest is as stated in the attached Declaration of Service. Declarations supporting the protests are presented by Tracy Cassel, J. Christopher Lynch, James C. Caulk, Paul Berg, Albert F. Roma, Jr. and John Nellessen. These Declarations include copies of the prior art relied upon in this Protest.

2. Protestor's Request for Denial of Reissue and Cancellation of All Claims

Applicant has failed to comply with 35 U.S.C. § 251; 37 C.F.R. §§ 1.56 and 1.171-1.179 and the provisions of MPEP Chapter 1400 in the prosecution of its Reissue application. It is clear that the subject matter of the '100 Patent and the Reissue application would have been obvious to any person of ordinary skill in mechanical arts as of the June 14, 1993 filing date or

any date claimed by the applicant pursuant to its purported Affidavits under 37 C.F.R. § 1.131. The requested Reissue should be denied and all Claims cancelled. 35 U.S.C. § 251; 37 C.F.R. § 1.176.

3. **The Applicant Fails to Identify the Basis for the ReIssue**

(a) **No specification or drawing defect is identified or offered to be corrected.**

Applicant does not identify the defect in its specification or drawings – indeed, the Applicant simply makes a conclusory allegation mirroring the statutory language of 35 U.S.C. § 251 without any explanation as to the nature of the defect or providing any suggested correction to the defect. This is a basis for denial of the reissue and for cancellation of the remaining claims supported by the admittedly defective specification. 35 U.S.C. § 251.

(b) **Applicant does not surrender over-broad claims and improperly attempts to obtain new over-broad claims.**

The issue date of the '100 Patent is January 27, 1998, and the filing date of this Reissue application is June 14, 1993; thus, under 35 U.S.C. § 251's last paragraph, the applicant cannot enlarge the scope of any claims. The applicant makes a conclusory allegation mirroring the language of 35 U.S.C. § 251 that it claimed more or less than it had a right to claim – but presents no explanation as to the nature of the defect. The applicant does not offer to surrender any of the initial claims and only presents new claims – all of this is in contravention of 35 U.S.C. § 251 and 37 C.F.R. § 1.178.

4. **Level of Ordinary Skill in the Art**

The appropriate level of ordinary skill is one with understanding of mechanical arts and, in particular, in vehicle signage, magnet design and basic fastening skills. This person of ordinary skill would be familiar generally with mechanical concepts, including the uses of plastics, signs, vehicles, magnets and fasteners as identified in the prior art. As demonstrated below, all of the claims would have been obvious to any person of ordinary skill who was exposed to the prior art.

5. **The Prior Art Discloses All Elements of the Claims**

The most fundamental reason this reissue should be denied and all Claims cancelled is that the subject of the invention is so clearly obvious and anticipated by the prior art that no patent should issue. Essentially, the applicant is taking the position that he has invented a

translucent sign with magnets – the applicant's combination is clearly obvious. Prior art patents and publications all existed prior to the purported dated of invention.

(a) Prior Art Critical Date.

The filing date of the '100 Patent is June 14, 1993. In prosecution of the '100 Patent, applicant submitted a 37 C.F.R. § 1.131 Affidavit, including a purported invoice with two dates, "10/30/92" and "9/25/92," in an attempt to avoid application of Canadian Patent No. 2,041,396. The invoice contains no drawings or other objective indication that the applicant had reduced its invention to practice prior to the effective prior art date of the Canadian Patent.

In prosecution of the Reissue application, applicant presents nothing objective to corroborate its conclusions as to date of purported invention– no internal drawings or sketches, no written descriptions, no drawings for the mold, no evidence of the reduction to practice the magnet assemblies or feet or coatings that are included in the claims. Thus, applicant has not met its obligations on the Reissue application that it reduced the purported invention to practice prior to June 14, 1993; nevertheless, the patent is invalid even if the purported invention occurred on October 30, 1992. All of the elements of the Claims in the '100 Patent and the requested new Claims are fully disclosed in the prior art, marked either from June 14, 1993 or October 30, 1992, as demonstrated below.

(b) Summary of all Claims and Categories of Prior Art.

All of the Claims of the '100 Patent and the new Claims requested in the Reissue application have certain elements in common:

- i.) An advertising sign or member – a translucent unitary box with base, ends and sides.
- ii.) The sign has feet in its base.
- iii.) Magnet assemblies are seated in the feet and secured therethrough.
- iv.) The magnet assemblies are secured in a manner that allows them limited movement.

Each of these areas was well known prior to the filing date or any alleged date of invention. Citations to the prior art are included in the submitted Declarations with their Exhibits and in the Claim-by-Claim analysis that follows this prior art summary.

(i) Signs are old.

Advertising signs for vehicle use or other uses where the sign is affixed to a metal surface are as old as vehicles. Use of fasteners for signs including screws, rubber suction cups or

magnets is likewise old. The '100 patent and the subject of the Reissue application are nothing more than an obvious combination of old elements – elements familiar to anyone in the sign business and anyone who ever needed to temporarily or permanently affix anything to a metal surface.

Much of the prior art within the decade preceding the applicant's filing date is not even the subject of published patents because the fundamental concepts had been put into the public domain even decades earlier. There are abundant examples of old art suggesting the applicant's combination – including top lights for vehicles, and taxi, delivery, political and other advertising signs that have been used on vehicles for decades.

The prior art of signage includes all elements imaginable, including uses of signs which are (1) enclosed and others not enclosed, (2) unitary and others pieced together, (3) internally lighted and others not internally lighted, (4) those made of translucent plastic and others made of other materials, (5) those with feet and others without feet – some coated or cushioned, some not, (6) those affixed with magnets and others affixed with other obvious substitutes. In other words, a sign base of the type relevant here is simply a functional space to display advertising – the applicant has contributed nothing new in this regard.

(ii) **Magnets are old.**

The prior art of magnets and other methods of affixing signs to metallic surfaces (or affixing any object of similar mass and size) – either temporarily or permanently is likewise very broad including uses of suction cups and screws and straps and magnets. The use of magnets to hold a sign has long been generally known.

(iii) **Magnet assemblies are old.**

The prior art of magnet assemblies used to facilitate affixing magnets to the object desired to be held is likewise broad and old. Of great importance to this Reissue application is that applicant never discloses that the magnet assembly to which Claim 1 and others are drawn (regarding the housing edge and coatings) is a stock public domain magnet assembly – generally called an “RB” or “Round Base” magnet assembly manufactured and distributed by numerous companies – the assembly in the application is in no manner the invention of the applicant. The Declarations included of James Caulk, John Nellesen and Albert Roma explain the public-domain nature of the RB family of magnet assemblies.

The prior art of magnet housings includes families of shaped magnets sold with protective housings and providing screw holes or other built-in manners for fastening. The RB

family of magnets, for example, includes ring magnets of all sizes and powers with central holes for screws or bolts. The housings protect the magnets and allow for easy coupling with the object affixed.

It has been entirely customary that these housings have edges in near-flush position relative to the magnets being housed – either above or slightly below a face of the magnet.

It is entirely customary that these housings and the magnet surfaces themselves are given finish coatings including plastic, fabric, rubber and other surface coatings so as to protect their metallic nature and to provide scratch resistance to the object affixed and its surface.

Of great importance here, the applicant did not invent the RB magnet assembly or its attributes – this type of magnet assembly has been an off-the-shelf product in the public domain for decades.

(iv) Screws and bolts are old.

The prior art of affixing magnets to signs and other things includes numerous examples of the use of screws or bolts – including bolts through central holes in a magnet and the assembly housing. Indeed, the RB families of magnet assemblies commonly available prior to applicant's date of claimed invention often include mounting hardware – for RB magnet assemblies often this is simply one central screw or bolt.

(v) Washers and grommets are old.

The prior art of affixing magnet assemblies includes the use of springs or rubber grommets or washers or other means for providing a flexible fit of the assembly to allow some limited relative movement of the magnet when placed. Suction cups are seen as an equivalent by the Declarants and the prior art and suction cups by their very nature allow this same limited relative movement when the sign is placed. Indeed, the prior art of affixing anything generally includes the notion whether it has to have some limited relative movement – screws can be tightly or more loosely secured to achieve similar results. The applicant in no manner invented the concept of using a washer or grommet (flexible sleeve) in conjunction with a screw or bolt to provide some limited range of movement of the magnet and its assembly.

(c) Declarations and Evidence of Patents and Publications Rendering the '100 Patent Claims and proposed Claims obvious.

The Protest presents prior art patents in its claim-by-claim analysis, but first presents Declarations from members of the sign industry which include prior art patents and publications which demonstrate that all of the Claim elements of the '100 Patent and the Reissue application

were old as of the filing date of the '100 Patent or any other claimed date of invention. The publications supplied include many advertisements in trade publications -- which appear sometimes in close proximity to advertisements for the applicant's company. The Declarations make clear that the applicant was well aware of many of these prior art products which in large part were not been disclosed in any manner to the Patent Office in the prosecution of the '100 Patent or the Reissue application.

(i) Declaration of James W. Caulk – Mr. Bill's International.

The Declaration of James W. Caulk is provided along with prior art Exhibits which are published disclosures of his company's designs. Mr. Caulk owns Mr. Bill's International – a vehicle sign company operating since 1987. The applicant discloses the name of Mr. Bill's sign in the its application, but provides no photo, model or copy of the un-patented reference nor any 37 C.F.R. § 1.56 disclosure of the sign. Mr. Caulk's Declaration and Exhibits provide clear evidence that the applicant's combination is old. Mr. Bill's produced and sold Twirl-n-Ad and Drive-n-Ad signs before the critical date in the United States and both of these signs used the RB-80 magnet assembly – as noted, the off-the-shelf common magnet assembly from suppliers such as Adams Manufacturing and to which the applicant draws its Claim 1 and all Claims depending from that Claim. The applicant did not invent the RB magnet assembly and it did not inform the Patent Office of this fact.

Mr. Bill's signs prior to the critical date used what they called a "floating magnet" in that the RB-80 magnet assemblies were attached to the sign base including use of flexible rubber grommets which provided limited relative movement when placing the sign on the vehicle -- an equivalent to the applicant's "idea."

Mr. Caulk's Declaration explains that his company's own patentability search on its signs turned up so much prior art that an application was not pursued – Mr. Caulk references the patents located in that search that led to his company's conclusion. Mr. Caulk also explains that the applicant was aware of the Mr. Bill's signs and their uses of the RB magnet assemblies. Clearly, the applicant does not disclose the relevance of the Mr. Bill's signs in the application, in contravention. 37 C.F.R. § 1.56.

Mr. Caulk's Declaration and the Exhibits explain and document the prior art of his company and the applicant's awareness of the same.

(iii) Declaration of Albert F. Roma – National Marketing, Inc.

The Declaration of Albert F. Roma is provided along with prior art Exhibits which are published disclosures of his company's designs. Mr. Roma owned a company, National Marketing, Inc., which manufactured and sold the below-described car-top advertising signs in the United States prior to the critical dates in the Reissue application.

National Marketing sold a plastic vehicle-top sign manufactured by a vacuum forming process which resulted in a translucent sign with a base, ends and sides which was then pieced together. Also, prior to the critical date, National Marketing also had another model using a base, ends and sides but which was manufactured by a rotational molding process that resulted in a translucent hollow body sign that was unitary, as opposed to pieced together like the sign manufactured by the vacuum forming process. These signs both had use of suction cups for placement on the vehicle roof and the rubberized suction cups provided a limited range of movement when placing the sign on the vehicle.

Mr. Roma explains that his company sold thousands of the signs and that the applicant was aware of National Marketing's signs.

Mr. Roma declares as an experienced person in the field that the applicant's device was a combination of old and obvious elements.

Mr. Roma's Declaration and the Exhibits explain and document the prior art of his company and the applicant's awareness of the same.

(iii) Declaration of Paul Berg – ICC Fabricating.

The Declaration of Paul Berg is provided along with prior art Exhibits which are published disclosures of his company's designs. Mr. Berg owned a company, ICC Fabricating, which manufactured and sold all of the below-described car-top advertising signs in the United States prior to the critical dates in the Reissue application. ICC had a CTSI model with a translucent hollow body, base, ends and sides held to the automobile by the use of a foot cooperating with a rack. The foot used the rubber grommet idea to provide limited flexibility.

ICC then moved to its CTSII model which was the subject of U.S. Patent Nos. 4,671,004 and 4,787,163. This design used a translucent hollow body with flexible suction cups with a central fastener.

ICC made a Magnetic Roof Rider model that included an equivalent of the RB-80 magnet assembly that was (and still is) sold by magnet suppliers such as Adams Manufacturing. This is the housing to which applicant has drawn Claim 1 without any disclosure that the housing

is old and that he did not invent it – or its use on vehicle signs. The ICC product used the magnet assembly and also included a rubber boot covering to protect from scratching.

Mr. Berg declares as an experienced person in the field that the applicant's device is a combination of old and obvious elements – and that the applicant knew of the ICC products from attending trade shows and seeing the applicant prior to the critical dates.

Mr. Berg's Declaration and the Exhibits explain and document the prior art of his company and the applicant's awareness of the same.

(iv) Declaration of John Nellessen – Master Magnetics.

The Declaration of John Nellessen is provided along with prior art Exhibits which are published disclosures of his company's designs. Mr. Nellessen owns a company, Master Magnetics, which manufactured and sold RB-family magnet assemblies in the United States prior to the critical dates in the Reissue application. Master Magnetics has manufactured and sold RB or "round base" magnet assemblies in the United States prior to the critical date – including the RB-80 assembly that the applicant claims as its invention in Claim 1 and those Claims depending from Claim 1. The stock RB-80 magnet has a metal housing with an edge or lip slightly below the face of the magnet, a housing into which the magnet is fit, and surface coatings.

Mr. Nellessen declares as an experienced person in the field that the applicant did not invent the RB-80 magnet assembly as is depicted in the application.

Mr. Nellessen's Declaration and the Exhibits explain and document the prior art of his company.

(v) Declaration of Tracy Cassel – AutoSox USA, Inc.

The Declaration of Tracy Cassel is provided along with prior art Exhibits. Mr. Cassel owns a company, AutoSox USA, Inc., which has manufactured and publicly used vehicle signs including the use of RB-80 magnet assemblies in the United States prior to the critical dates in the Reissue application. Mr. Cassel has been in the vehicle sign business for many years and he has personal knowledge of the applicant and the applicant's business. Mr. Cassel is aware and demonstrates that the applicant failed in his duty of candor with the Patent Office by not identifying known prior art, including that he did not invent the RB-80 magnet assembly that is the subject of Claim 1 and all of the other aspects of the claimed invention that were, in fact, old at the time of the application.

Mr. Cassel declares as an experienced person in the field that the applicant did not invent the various elements of his claimed invention and that these aspects were well known in the industry prior to the critical date.

Mr. Cassel's Declaration and the Exhibits explain and document the prior art of his company and the applicant's awareness of the same.

(d) The '100 Patent Claims and proposed Claims are not patentable.

In particular, each claim in the '100 Patent and in the Reissue application remain defective for failure to comply with 35 U.S.C. § 112 and in light of the prior art under 35 U.S.C. §§ 102-103.

The Protest addresses the deficiencies claim-by-claim. Independent Claims are 1, 2 and 4. The order of the analysis is grouped on these independent Claims: (Group 1) Claim 1 and then Claims 7, 8, 9, 10, 11 and 12 which depend from Claim 1; (Group 2) Claim 2 and Claims 3, 13, 14 and 15 which depend from Claim 2; (Group 3) Claim 4 and Claims 5 and 6 which depend from Claim 4. The claim text is presented followed by the analysis.

(e) Group 1: Claim 1 and dependent Claims 7, 8, 9, 10, 11 and 12.

i. Claim 1:

An advertising sign comprising:

1. Ad member

- a. having **base ends and sides** formed together into completely enclosed hollow body
- b. base including plural **magnet receptacles**
- c. **magnet** fastened in each receptacle

2. Each magnet comprising

- a. dish shaped **housing** with magnetic member inside each housing
- b. housing having an **edge** extended below magnetic member

3. Pivot attachment means between magnet and base

- a. so each magnet can pivot and adjust.

Analysis of Claim 1:

35 U.S.C. § 112:

There is no antecedent basis for the word "receptacle" in the application. The only reasonable interpretation is that it is equivalent to a "foot." However, the prior art discloses several instances of the use of a sign with feet, as noted below. Thus, Claim 1 falls under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

The prior art discloses **signs for use on vehicles**. See Declaration of Paul Berg; Declaration of Albert Roma; Declaration of Tracy Cassel; Declaration of James Caulk; Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 1); B (Fig. 2); C (Fig. 2); D (Fig. 1); E (Fig. 1); F (Fig. 1-2); G (Fig. 2-3); H (Fig. 1); I (Fig. 1-2); J (Fig. 1, 5); K (Fig. 5); L (Fig. 1); M (Fig. 1-2); N (Fig. 1); O (Fig. 1); P (Fig. 2); Q (Fig. 1-2); R (Fig. 1); S (Fig. 1-2); U (Fig. 1-2); V (Fig. 1-2); W (Fig. 1, 3); X (Fig. 1-2); Y (Fig. 1-2); Z (Fig. 1-2); MM (Fig. 1, 3); QQ (Fig. 1); RR (Fig. 1); SS (Fig. 1) and TT (Fig. 1-2).

The prior art discloses **signs with bases, ends and sides**. See Declaration of Paul Berg; Declaration of Albert Roma; Declaration of Tracy Cassel; Declaration of James Caulk; Declaration of J. Christopher Lynch and Exhibits identified as: K (Fig. 1, 4); L (Fig. 1, Col. 2, Ln. 12-30); N (Fig. 2-3); O (Fig. 1, 3); P (Fig. 1, 3-4); Q (Fig. 2); S (Fig. 2, 4); U (Fig. 1, 4); V (Fig. 1-3); Y (Fig. 1-2); QQ (Fig. 1, 5) and TT (Fig. 1-2, 3, 7).

The prior art discloses **signs with hollow bodies – both unitary and pieced together**. See Declaration of Paul Berg; Declaration of Albert Roma; Declaration of Tracy Cassel; Declaration of James Caulk; Declaration of J. Christopher Lynch and Exhibits identified as: J (Pg. 3, Ln. 12-Pg. 4, Ln. 23); K (Fig. 1, 4); L (Fig. 1); O (Fig. 2, Col. 2, Ln. 33-53); P (Fig. 1); Q (Fig. 2); U (Fig. 1, 4); W (Fig. 3); Y (Fig. 1-2); QQ (Fig. 1, 3; Col. 1, Ln. 50-Col. 2, Ln. 25) and TT (Fig. 1-3).

The prior art discloses **signs with feet or receptacles in the base for use in affixing the signs – both with magnets and other methods of affixation**. See Declaration of Paul Berg; Declaration of Albert Roma; Declaration of Tracy Cassel; Declaration of James Caulk; Declaration of John Nellessen; Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 1-2, 4); B (Fig. 2, 4-5); C (Fig. 2); G (Fig. 2); I (Fig. 2, 4-5); J (Fig. 4-6); S (Fig. 3, 6-7); T (Fig. 3-6); PP (Fig. 2); QQ (Fig. 5; Col. 2, Ln. 16-25); RR (Fig. 3) and SS (Fig. 5, Ref. No. 91).

The prior art discloses **signs with magnets, suction cups or other means of affixation** between the feet or base and the surface to which the sign is secured. *See* Declaration of Paul Berg; Declaration of Albert Roma; Declaration of Tracy Cassel; Declaration of James Caulk; Declaration of John Nellessen; Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 4); B (Fig. 2,5); C (Fig. 2); D (Fig. 2-3); E (Fig. 1); F (Fig. 4); G (Fig. 2); H (Fig. 2); I (Fig. 2, 4); J (Fig. 6); M (Fig. 3); N (Col. 2, Ln. 5-23); O (Fig. 3); P (Fig. 5-6); Q (Fig. 2, 4-5); R (Fig. 1-5); S (Fig. 3-7); T (Fig. 3-6); U (Fig. 2); V (Fig. 1-2, 4); W (Fig. 3); X (Fig. 2-4); Y (Fig. 1-2); Z (Fig. 2-3); AA (Fig. 1-3); MM (Fig. 2); PP (Fig. 2); RR (Fig. 3); TT (Col. 2, Ln. 20-35) and UU (Fig. 1, 4-5).

The prior art discloses the use of **magnet housings**. *See* Declaration of Paul Berg; Declaration of Albert Roma; Declaration of Tracy Cassel; Declaration of James Caulk; Declaration of John Nellessen; Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 4-6); C (Fig. 2); F (Fig. 2, 4); I (Fig. 2-5); Q (Fig. 3-5); R (Fig. 3-5); BB (Fig. 1-2); CC (Fig. 1-20); DD (Fig. 1-3); EE (Fig. 2-5); FF (Fig. 5-6); GG (Fig. 3-6); HH (Fig. 1-4); JJ (Fig. 1-4); KK (Fig. 2-3); MM (Fig. 2); NN (Fig. 1-6); OO (Fig. 2-5-6) and OO (Fig. 2-5).

The prior art discloses **magnet assemblies with the dish or other shaped housings having edges extending both above and below the magnets**. *See* Declaration of Paul Berg; Declaration of Albert Roma; Declaration of Tracy Cassel; Declaration of James Caulk; Declaration of John Nellessen; Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 5; housing edge below magnet plane); F (Fig. 4; housing edge below magnet plane); I (Fig. 5; housing edge below magnet plane); Q (Fig. 3, 5); R (Fig. 2-5; housing edge below magnet plane); BB (Fig. 1); CC (Fig. 1) and KK (Fig. 3).

The prior art discloses the use of **flexible coupling of magnets or other means of affixation**. Suction cup use is equivalent in that they are flexible by their nature; thus, affixation by suction cups is included in this listing of the prior art. *See* Declaration of Paul Berg; Declaration of Albert Roma; Declaration of James Caulk; Declaration of Tracy Cassel; Declaration of John Nellessen; Declaration of J. Christopher Lynch and Exhibits identified as: I (Col. 2, ln. 45-60); J (Fig. 6, ref. 115); S (Col. 2, ln. 3-10); Z (Fig. 3); AA (Fig. 1-3); BB (Fig. 1-2); CC (Fig. 1); DD (Fig. 2); EE (Fig. 2); GG (Fig. 3, 6); HH (Fig. 10); II (Fig. 3-4); JJ (Fig. 2,4); KK (Fig. 2, 4); LL (Fig. 1) and NN (Fig. 4).

Thus, Claim 1 falls under 35 U.S.C. §§ 102-103.

ii. Claim 7:

Claim 1, wherein

The magnet receptacles

Collectively surround

All of the magnets.

Analysis of Claim 7:

35 U.S.C. § 112:

The application does not disclose "receptacle," as noted above regarding Claim 1. The application makes no disclosure or explanation of "surround" or "collectively surround." Thus, there is no antecedent basis for these "receptacles" to "collectively surround" the magnets -- the application at no point explains that the feet collectively surround anything other than each foot arguably surrounds one magnet assembly. In addition, the proposed Claim suffers as a dependent Claim of invalid Claim 1. For these reasons, the proposed Claim fails under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

All of the prior art relating to Claim 1, as detailed above, applies to this Claim.

The prior art discloses the use of **magnet housings that may be seen as surrounding a particular magnet.** See Declaration of Tracy Cassel; Declaration of John Nellessen; Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 4-5); C (Fig. 2, 9); F (Fig. 4); I (Fig. 2, 5); Q (Fig. 4-5); S (Fig. 3, 6-7); W (Col. 2, ln. 30-40 equates magnets to suction cups); BB (Fig. 1-2); CC (Fig. 1); EE (Fig. 2-5); FF (Fig. 5); KK (Fig. 2) and OO (Fig. 3-4).

The prior art discloses the use of **feet which may be seen as surrounding a particular magnet.** See Declaration of Tracy Cassel; Declaration of John Nellessen; Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 4-5); B (Fig. 2); G (Fig. 2); I (Fig. 2, 5); J (Fig. 6) and S (Fig. 3, 6-7).

Thus, the proposed Claim falls under 35 U.S.C. §§ 102-103.

iii. Claim 8:

Claim 7 wherein

Each plural magnet receptacle

Surrounds at least one of the magnet

Analysis of Claim 8:

35 U.S.C. § 112:

There is no antecedent basis in the application for "surround," or, as noted above, for "receptacle." Plain language interpretation of this term would require that the surrounded element be completely enveloped by the surrounding element – the only thing offered as directly surrounding any magnet is the magnet assembly housing. There is no disclosure that all of the feet surround one of the magnets. Each foot may surround one particular magnet – but there is no disclosure matching the ambiguous proposed Claim language that each receptacle surrounds at least one of the magnets. In addition, the proposed Claim suffers as a dependent Claim of invalid Claim 1. For these reasons, the proposed Claim fails under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

The prior art regarding Claims 1 and 7 is likewise comprehensive to block proposed Claim 8. Thus, the proposed Claim falls under 35 U.S.C. §§ 102-103.

iv. Claim 9:

Claim 7 wherein

The magnet receptacles

Extend below the base.

Analysis of Claim 9:

35 U.S.C. § 112:

As noted above, applicant does not disclose the term "receptacle" or give any explanation of the term. The application uses the term "foot" and the prior art shows many uses of a foot regarding placing and affixing signage. Thus, there is no antecedent basis in the application for the claim language that the receptacle extends below the base. Indeed, the application shows that the foot extends upward into the sign body to accept the affixing-screw (*see* 113 at Figure 1a.) In addition, the proposed Claim suffers as a dependent Claim of invalid Claim 1. For these reasons, the proposed Claim fails under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

The prior art discloses the use of feet **protruding from a sign** for use in placing and affixing the sign. See Declaration of Paul Berg; Declaration of Albert Roma; Declaration of Tracy Cassel; Declaration of James Caulk; Declaration of John Nellessen; Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 1-2, 4); B (Fig. 2, 4-5); C (Fig. 2); G (Fig. 2); I (Fig. 2, 4-5); J (Fig. 4-6); S (Fig. 3, 6-7); T (Fig. 3-6); PP (Fig. 2); QQ (Fig. 5; Col. 2, Ln. 16-25); RR (Fig. 3) and SS (Fig. 5, Ref. No. 91).

Thus, the proposed Claim falls under 35 U.S.C. §§ 102-103.

v. **Claim 10:**

Claim 9 wherein

Each magnet receptacle

Extends below an **adjacent side**

Analysis of Claim 10:

See analysis for Claim 9 above. Claim 10 is invalid under 35 U.S.C. § 112 and §§ 102-103.

vi. **Claim 11:**

Claim 10 wherein

Each magnet receptacle

Extends below an **adjacent end**.

Analysis of Claim 11:

See analysis for Claim 10 above. Claim 11 is invalid under 35 U.S.C. § 112 and §§ 102-103.

vii. **Claim 12:**

Claim 1 wherein

The **edge** of the dish-shaped housing

Has a **plastic coating** covering the housing's edge.

Analysis of Claim 12:

35 U.S.C. § 112:

The application does not disclose any use of plastic material on the edge of the housing of the magnet assembly. In addition, the proposed Claim suffers as a dependent Claim of invalid Claim 1. For these reasons, the proposed Claim fails under 35 U.S.C. § 112.

35 U.S.C. § 102-103:

The prior art discloses the use of rubber, felt or plastic or other cushioning/anti-scratch material on the magnets or other methods of affixing signage. See Declaration of Paul Berg; Declaration of Albert Roma; Declaration of Tracy Cassel; Declaration of James Caulk; Declaration of John Nellesen; Declaration of J. Christopher Lynch and Exhibits identified as: B (Fig. 2, ref. 21); G (Fig. 2, ref. 16); EE (Fig. 4, ref. 44); QQ (Fig. 5, ref. 24) and SS (Fig. 5, ref. 91).

(f) Group 2: Claim 2 and dependent Claims 3, 13, 14 and 15

i. Claim 2:

An advertising sign comprising:

1. Ad member
 - a. having base ends and sides formed together into completely enclosed hollow body
2. plural magnets
3. Pivot attachment means between magnet and base
 - a. — so each magnet can pivot and adjust
 - b. means comprises flexible sleeve between magnet and base.

Analysis of Claim 2:

35 U.S.C. § 112:

The application has no antecedent basis for the term "formed together" other than as creation as a unitary, water impervious molded sign. There is no antecedent basis for any interpretation of this claim to include a sign having a base, ends and sides which are pieced together.

Thus, the Claim falls under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

As noted above regarding Claim 1, there is considerable prior art regarding the use of a **sign formed together or pieced together**. See Declaration of J. Christopher Lynch and Exhibits identified as: J (Pg. 3, Ln. 12-Pg. 4, Ln. 23); K (Fig. 1, 4); L (Fig. 1); O (Fig. 2, Col. 2, Ln. 33-53); P (Fig. 1); Q (Fig. 2); U (Fig. 1, 4); W (Fig. 3); Y (Fig. 1-2); QQ (Fig. 1, 3; Col. 1, Ln. 50-Col. 2, Ln. 25) and TT (Fig. 1-3).

As noted above regarding Claim 1, there is considerable prior art regarding the use of **magnets or suction cups on signs**. See Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 4); B (Fig. 2,5); C (Fig. 2); D (Fig. 2-3); E (Fig. 1); F (Fig. 4); G (Fig. 2); H (Fig. 2); I (Fig. 2,4); J (Fig. 6); M (Fig. 3); N (Col. 2, Ln. 5-23); O (Fig. 3); P (Fig. 5-6); Q (Fig. 2, 4-5); R (Fig. 1-5); S (Fig. 3-7); T (Fig. 3-6); U (Fig. 2); V (Fig. 1-2, 4); W (Fig. 3); X (Fig. 2-4); Y (Fig. 1-2); Z (Fig. 2-3); AA (Fig. 1-3); MM (Fig. 2); PP (Fig. 2); RR (Fig. 3); TT (Col. 2, Ln. 20-35) and UU (Fig. 1, 4-5).

As noted in the Lynch Declaration, Exhibit W, column 2, lines 30-40, use of magnets or suction cups as a temporary affixation manner is only a matter of design choice -- not an inventive difference.

As noted above regarding Claim 1, there is considerable prior art regarding the use of **rubber grommets, washers, springs and other flexible sleeves to position magnets**. See Declaration of J. Christopher Lynch and Exhibits identified as: I (Col. 2, ln. 45-60); J (Fig. 6, ref. 115); S (Col. 2, ln. 3-10); Z (Fig. 3); AA (Fig. 1-3); BB (Fig. 1-2); CC (Fig. 1); DD (Fig. 2); EE (Fig. 2); GG (Fig. 3, 6); HH (Fig. 10); II (Fig. 3-4); JJ (Fig. 2,4); KK (Fig. 2, 4); LL (Fig. 1) and NN (Fig. 4).

Thus, the Claim falls under 35 U.S.C. §§ 102-103.

ii. Claim 3:

Claim 2 plus

3. Pivot attachment means comprises

a. fastener through each magnet, its flexible sleeve and into the base.

Analysis of Claim 3:

35 U.S.C. § 112:

As noted for Claim 2, the application has no antecedent basis for a the term "formed together" other than as creation as a unitary, water impervious molded sign. There is no

antecedent basis for any interpretation of this claim to include a sign having a base, ends and sides which are pieced together. In addition, the proposed Claim suffers as a dependent Claim of invalid Claim 2. For these reasons, the Claim fails under 35 U.S.C. § 112.

35 U.S.C. §§102-103:

There is considerable prior art invalidating Claim 2, as noted above. Claim 3 does nothing more than limit the fastening of the magnet by the use of a fastener through the magnet - and there is considerable prior art on the use of fasteners -- such as screws or bolts through magnets. See Declaration of J. Christopher Lynch and Exhibits identified as: B (Fig. 2); I (Fig. 2); R (Fig. 2); U (Fig. 2); V (Fig. 3-4); W (Fig. 3); X (Fig. 2, 4); Y (Fig. 1); Z (Fig. 3); AA (Fig. 2); CC (Fig. 1); EE (Fig. 4); II (Fig. 3); JJ (Fig. 2-3); MM (Fig. 2); NN (Fig. 1); TT (Fig. 7) and VV (Fig. 2).

Thus, the Claim falls under 35 U.S.C. §§ 102-103.

iii. Claim 13:

Claim 2 wherein

The advertising member further comprises:

Magnet receptacle means

Extending below and around the base

Surrounding all of the magnets.

Analysis of Claim 13:

35 U.S.C. § 112:

As detailed regarding Claims 7 and 8 above, there is no antecedent basis for "receptacle" or any notion of "surrounding." The only disclosure of a receptacle is a "foot" and the application makes no disclosure of a foot surrounding all of the magnets. In addition, the proposed Claim suffers as a dependent Claim of invalid Claim 2. For these reasons, the proposed Claim fails under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

As noted above regarding Claims 1, 7 and 8, there is considerable prior art regarding the use of sign feet holding magnets. See Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 4); B (Fig. 2,5); C (Fig. 2); D (Fig. 2-3); E (Fig. 1); F (Fig. 4); G (Fig. 2); H (Fig. 2); I (Fig. 2,4); J (Fig. 6); M (Fig. 3); N (Col. 2, Ln. 5-23); O (Fig. 3); P (Fig. 5-6); Q (Fig.

2, 4-5); R (Fig. 1-5); S (Fig. 3-7); T (Fig. 3-6); U (Fig. 2); V (Fig. 1-2, 4); W (Fig. 3); X (Fig. 2-4); Y (Fig. 1-2); Z (Fig. 2-3); AA (Fig. 1-3); MM (Fig. 2); PP (Fig. 2); RR (Fig. 3); TT (Col. 2, Ln. 20-35) and UU (Fig. 1, 4-5).

Thus, the Claim falls under 35 U.S.C. §§ 102-103.

iv. **Claim 14:**

Claim 13 wherein

The magnet receptacle means

Extends below an adjacent side

Analysis of Claim 14:

35 U.S.C. §§ 112:

As noted above regarding Claim 1, there is no antecedent basis for "receptacle" and thus there is no antecedent basis for a receptacle having any dimension compared to the sign body. In addition, the proposed Claim suffers as a dependent Claim of invalid Claim 2. For these reasons, the proposed Claim fails under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

As noted above, there is considerable prior art regarding the use of feet protruding from a sign body. See Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 4); B (Fig. 2,5); C (Fig. 2); D (Fig. 2-3); E (Fig. 1); F (Fig. 4); G (Fig. 2); H (Fig. 2); I (Fig. 2,4); J (Fig. 6); M (Fig. 3); N (Col. 2, Ln. 5-23); O (Fig. 3); P (Fig. 5-6); Q (Fig. 2, 4-5); R (Fig. 1-5); S (Fig. 3-7); T (Fig. 3-6); U (Fig. 2); V (Fig. 1-2, 4); W (Fig. 3); X (Fig. 2-4); Y (Fig. 1-2); Z (Fig. 2-3); AA (Fig. 1-3); MM (Fig. 2); PP (Fig. 2); RR (Fig. 3); TT (Col. 2, Ln. 20-35) and UU (Fig. 1, 4-5).

Thus, the Claim falls under 35 U.S.C. §§ 102-103.

v. **Claim 15:**

Claim 14 wherein

The magnet receptacle means

Extends below an adjacent end.

Analysis of Claim 15:

35 U.S.C. §112:

As noted above regarding Claim 1, there is no antecedent basis for "receptacle" and thus there is no antecedent basis for a receptacle having any dimension compared to the sign body. In addition, the proposed Claim suffers as a dependent Claim of invalid Claim 2. For these reasons, the proposed Claim fails under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

As noted above, there is considerable prior art regarding the use of **feet protruding from a sign body**. See Declaration of J. Christopher Lynch and Exhibits identified as: A (Fig. 4); B (Fig. 2,5); C (Fig. 2); D (Fig. 2-3); E (Fig. 1); F (Fig. 4); G (Fig. 2); H (Fig. 2); I (Fig. 2,4); J (Fig. 6); M (Fig. 3); N (Col. 2, Ln. 5-23); O (Fig. 3); P (Fig. 5-6); Q (Fig. 2, 4-5); R (Fig. 1-5); S (Fig. 3-7); T (Fig. 3-6); U (Fig. 2); V (Fig. 1-2, 4); W (Fig. 3); X (Fig. 2-4); Y (Fig. 1-2); Z (Fig. 2-3); AA (Fig. 1-3); MM (Fig. 2); PP (Fig. 2); RR (Fig. 3); TT (Col. 2, Ln. 20-35) and UU (Fig. 1, 4-5).

Thus, the Claim falls under 35 U.S.C. §§ 102-103.

(f) Group 3: Claim 4 and dependent Claims 5 and 6.

i. Claim 4:

An advertising sign comprising:

1. **Ad member**
 - a. **formed of a hollow, translucent and completely enclosed body**
 - b. **having a base, ends and sides**
 - c. **formed of a unitary molded plastic**
 - d. **including plural molded feet**
 - e. **extending from and forming a part of the base**
 - f. **receptacle in each base**
 - g. **shaped to receive a magnet assembly**
2. **plural magnet assemblies including**
 - a. **non-metallic, dish-shaped housing**

- b. magnet within housing
- c. housing edge extending below magnet
- 3. fastening means for each magnet assembly
 - a. within foot receptacle
 - b. attaching each magnet
 - c. within receptacle
 - d. so a portion of magnet extends below its receptacle

Analysis of Claim 4:

35 U.S.C. § 112:

The application discloses that the housing of the magnet assembly is in fact metallic, not non-metallic. Thus, the Claim falls under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

As noted above regarding Claims 1, 2 and 3, all of the elements of this Claim 4 are taught in the prior art.

Thus, the Claim falls under 35 U.S.C. §§ 102-103.

ii. **Claim 5:**

Claim 4 plus

- 1. means for pivotally attaching each magnet assembly
 - a. in the receptacle
 - b. so each magnet can adjust

Analysis of Claim 5:

35 U.S.C. § 112:

The proposed Claim suffers as a dependent Claim of invalid Claim 4. For these reasons, the proposed Claim fails under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

As noted above regarding Claims 1, 2, 3 and 4 all of the elements of this Claim 5 are taught in the prior art.

Thus, the Claim falls under 35 U.S.C. §§ 102-103.

iii. Claim 6:

Claim 5 plus

1. **pivotal attachment means** comprises
 - a. **flexible sleeve** between each “magnetic assembly” and base
 - b. **fastener** through each magnet, its flexible sleeve and into the base.

Analysis of Claim 6:

35 U.S.C. § 112:

The proposed Claim suffers as a dependent Claim of invalid Claim 4. For these reasons, the proposed Claim fails under 35 U.S.C. § 112.

35 U.S.C. §§ 102-103:

As noted above regarding Claims 1, 2, 3 and 4 all of the elements of this Claim 6 are taught in the prior art.

Thus, the Claim falls under 35 U.S.C. §§ 102-103.

6. **The Applicant Has Failed in His Duty of Candor with the Patent Office**

It is clear from the Declarations that the applicant appears to have completely failed in his duty of candor with the Patent Office to identify known prior art and that aspects of the Claims are simply third-party off-the-shelf assemblies and applications in which the applicant appears to claim inventorship – the only conclusion is that any alleged “errors” of the applicant thus were made by the applicant with deceptive intent. That is, applicant appears to have known that he did not disclose prior art or explain its relevance, he knew he did not invent the sub-assemblies of his claimed invention, he failed to disclose any of this to the Patent Office and he failed to clarify any of these defects in the Reissue application. The only logical conclusion is that the applicant did all of this with deceptive intent.

7. **This is a Litigation Reissue Application**

Applicant has filed a one-count lawsuit for infringement of the ‘100 Patent against AutoSox USA, Inc., a competitor who manufactures a vehicle-top translucent sign pieced together which includes the use of magnet assemblies affixed at the corners of the sign and covered by a rubberized boot to protect the vehicle surface. Elmer v. Goldenrod et al., Case No. 6:01-cv-673-Orl-28JGG, M.D. Fla.

AutoSox is defending that case on the basis that it is not an infringer of any of the Claims of the '100 Patent and it has brought a Counterclaim for a declaration of invalidity of the '100 Patent based on the breadth of the prior art and the applicant's apparent lack of candor with the Patent Office in failing to disclose known prior art and that he did not invent the claimed sub-assemblies that are part of the claimed invention. *See Declaration of Tracy Cassel.* In discovery to date, the inventor and its prosecution counsel have not provided copies of prosecution files from the '100 Patent, including the known prior art nor has the inventor subjected himself to deposition in the matter.

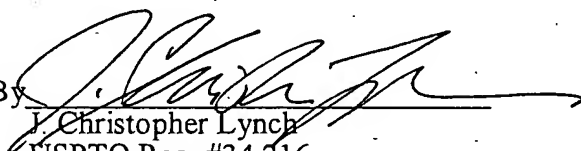
The inventor has requested and been granted a stay of the litigation, including blocking the defendant from pursuit of the invalidity defense while the inventor is pursuing this meritless Reissue application. The U.S. Patent Office should see this Reissue application for what it is – an improper attempt to obtain patent rights on an obvious combination of old art long in the public domain.

8. Conclusion

Applicant has completely failed to comply with 35 U.S.C. § 251; 37 C.F.R. §§1.56 and 1.171-1.179 and MPEP Chapter 1400. This Protest respectfully requests that the requested reissue should be denied and all claims cancelled. 35 U.S.C. §§ 102-103; 112; 251.

DATED this 1st day of November, 2002.

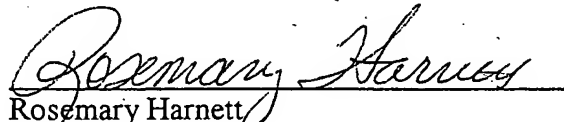
PRESTON GATES & ELLIS LLP

By 
J. Christopher Lynch
USPTO Reg. #34,216
Attorneys for AutoSox USA, Inc.-----

CERTIFICATE OF MAILING

I hereby certify that this PROTEST OF REISSUE APPLICATION is being deposited with the United States Postal Service as Express Mail on the 1st day of November, 2002, in an envelope addressed to the following:

- and
- (1) The Assistant Commissioner for Patents, BOX DAC, Washington, D.C. 20231,
 - (2) Mr. Herbert L. Allen, Allen, Dyer, Doppelt, Franjola & Milbrath, P.A.
255 South Orange Avenue, Suite 1401, Orlando, FL 32802-3791
Attorneys for William A. Elmer, Applicant


Rosemary Harnett

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